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EXAMINER

DYE, RENA

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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN MACALISTER and PETER MALONE

Appeal 2008-1520
Application 09/905,261
Technology Center 1700

Decided: August 20, 2008

Before BRADLEY R. GARRIS, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 4-9, 14-18, 25-28, and 31-41, the only claims pending in the application.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and enter a new ground of rejection.

¹ Our Decision will refer to the Amended Appeal Brief, filed February 12, 2007 (“Br.”) and to the Corrected Examiner’s Answer, mailed October 22, 2007 (“Ans.”).

Claims 1 and 25² are illustrative of the invention:

1. A mount releasably adhered to a single sheet of a backing material, the mount consisting of a single layer of plastic such as PVC and being a mount for mounting a sheet object to glass, and comprising a body having a first surface carrying an adhesive coating which adheres the mount to part of the surface of a sheet object to form a mountable arrangement, and a second surface which secures such a mountable arrangement directly to glass without adhesive.

25. A mount for mounting a sheet object to glass, consisting of a single layer of plastic such as PVC and having a first surface carrying an adhesive coating which adheres the mount to a sheet object permanently or releasably to form a mountable arrangement and a second surface which secures such a mountable arrangement directly to glass without adhesive, where the first and second surfaces are mutually opposite[.]

The Examiner relies on the following prior art references to show unpatentability:

Treglown	GB 2 333 050 A	Jul. 14, 1999
Wilkins '803	US 6,038,803	Mar. 21, 2000

Appellants request review of the following grounds of rejection³ (Br. 19):

² Claims 1 and 25 are reproduced from the Claims Appendix to Appellants' Brief. (See Br. 25-26.)

³ The Examiner acknowledges that claims 1, 4-9, 14-18, 25-28, and 31-41 are the only claims pending (Final Rejection mailed April 18, 2006, p. 2) and on appeal. (Ans. 2, ¶ (3).) The Examiner thus erred in identifying canceled claim 24 as rejected under 35 U.S.C. § 102(e) (Ans. 3), and canceled claims 10 and 19, 2-3, and 11-12 as subject to separate grounds of rejection under 35 U.S.C. § 103(a). (Ans. 4-5.) Appellants have not filed a Reply Brief or otherwise attempted to respond to the rejections of these claims. (See Br. 20-23.) Accordingly, we view the Examiner's mistake as harmless error.

1. Claims 25-28 and 33-40 under 35 U.S.C. § 102(e) as anticipated by Wilkins. (Ans. 3.)

2. Claims 1, 4-8, 13, 16-18, and 41 under 35 U.S.C. § 103(a) as unpatentable over Wilkins. (Ans. 4.)

3. Claims 14, 15, 31, and 32 under 35 U.S.C. § 103(a) as unpatentable over Wilkins. (Ans. 5.)

4. Claims 1 and 9 under 35 U.S.C. § 103(a) as unpatentable over Treglown in view of Applicants' Admission. (Ans. 6.)

Appellants' arguments are directed to the individual references and are not identified as being directed to a specific ground of rejection or to any particular claim on appeal. (Br. 20, third paragraph; Ans. 6 (10); *see generally*, Br. 20-23.) Our analysis below treats each ground of rejection under a separate heading. *See* 37 C.F.R. § 41.37(c)(1)(vii). We have considered Appellants' arguments in connection with each ground of rejection to the extent they relate to limitations which appear in the claims subject to that ground of rejection.

(1) Rejection of Claims 25-28 and 33-40 under 35 U.S.C. § 102(e) as anticipated by Wilkins

Independent claims 25, 36, and 40 require, *inter alia*, a mount having (1) a first surface carrying an adhesive coating and securable to a material such as paper and (2) a mutually opposite, second surface which is capable of securing the mount directly to glass without an adhesive.

The Examiner contends that Appellants' mount, as claimed, reads on Wilkins' covering E. More specifically, the Examiner finds that Wilkins' covering E is a "static cling" sheet comprising a single layer of plastic, such as PVC, having a first surface carrying an adhesive for releasably securing

the covering E to a first material (protective layer F) and having a second surface, opposite the first surface, which is capable of being secured to a second material (e.g., glass) without the use of an adhesive. (Ans. 3-4 and 8-9.)

Appellants do not dispute that Wilkins discloses a structure E having a first surface which may be releasably secured⁴ to a protective layer F. (Br. 23, third paragraph.) However, Appellants contend that Wilkins does not disclose a second surface, mutually opposite the first surface, which is capable of being secured directly to glass without adhesive. (Br. 23, fourth paragraph.)

The issue presented is: Does a preponderance of the evidence weigh in favor of the Examiner's finding that Wilkins discloses a mount having a second surface, mutually opposite the first surface, which is capable of being secured directly to glass without adhesive? We answer this question in the negative for the reasons discussed below.

The following findings of fact are relevant:

- 1) Wilkins discloses "a system for decorating pictures with a seasonal or other special display. The system includes a picture holder A which includes an original picture B and a frame C. The frame C surrounds a glass cover 1 overlying the original picture B." (Col. 3, ll. 14-18.) "A decorative covering D includes a front surface 8 . . . and a rear surface 10. . . . The front surface 8 includes a decorative display having a pictorial

⁴ Appellants do not agree with the Examiner's finding that Wilkins' first surface includes an adhesive. However, Appellants concede that Wilkins discloses a first surface which may be releasably secured to glass or a protective layer via static cling. (See, e.g., Br. 21-22.)

area 12 as well as a uniformed border area 14.” (Col. 3, ll. 28-31.) “The front surface 8 is opaque so that the original picture cannot be seen through the decorative covering D.” (Col. 3, ll. 48-49.)

2) According to Wilkins:

[T]he decorative covering D is preferably formed from a material exhibiting static cling so that the covering can be readily mounted on numerous surfaces including glass overlying an original picture. The material may be a vinyl formed from a polyvinyl chloride material through a well known manufacturing process. Once again the particular material used can be varied provided that the chosen material exhibits static cling to permit the decorative covering D to be electrostatically adhered over the original picture B. Optionally, a tacky adhesive may be used to secure the decorative covering D to the original picture B. (Col. 3, ll. 50-60.)

3) Wilkins discloses a first embodiment (shown in FIG. 3) in which “the rear surface 10 includes a template 16 and an instruction area 18.” (Col 3, ll. 61-62.)

4) Wilkins discloses a second embodiment (shown in FIG. 5) which differs from the first embodiment in that the rear surface does not have a template or an instruction area. (Col. 4, ll. 24-29.)

Rather, a protective backing F is provided which has a front surface 20 directly adjacent the rear surface of the decorative covering E. The protective backing further has a rear surface 22

with a template 24 and an instruction area 26. The protective backing F may be formed from any material which can be electrostatically adhered to the decorative covering E. Optionally, a tacky adhesive may be used to secure the decorative covering E to the original picture. (Col. 4, ll. 29-36.)

5) Prior to the filing date of Wilkins (5/6/1998), it was known that cling properties could be imparted to only one surface of a polyvinyl chloride (“PVC”) sheet material through the use of additives such as plasticizers, tackifiers, etc., U.S. Patent 6,194,062, issued 2/27/2001 from U.S. Application 08/745,340, filed 11/08/1996, col. 1, ll. 30-38 (discussing known prior art materials).

Anticipation requires that every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). “[A] prior art reference without express reference to a claim limitation may nonetheless anticipate by inherency.” *In re Omeprazole Patent Litigation*, 483 F.3d 1364, 1373 (Fed. Cir. 2007). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Inherency, however, may not be established by probabilities or possibilities. *Id.* The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.*

The Examiner's rejection is based on a finding that Appellants' claimed first surface carrying an adhesive coating reads on Wilkins' rear surface 10 and Appellants claimed second surface (i.e., the surface capable of being secured directly to glass without adhesive) reads on Wilkins' front surface 8. (*See* Ans. 3-4 and 8-9.) The Examiner does not reference, nor do we find, an explicit statement in Wilkins that the front surface 8 of decorative covering E is capable of being secured directly to glass without adhesive. (*See* Ans. 3-9; FF 1-2.) Rather, the Examiner implicitly relies on a finding that Wilkins' front surface 8 would inherently possess this feature when formed from a polyvinyl chloride material. (*See, e.g.*, Ans. 9 ("the adhesive surface of the static cling PVC is indirectly adhering to the paper (F) and the without-adhesive surface is indirectly securing the PVC(E) to the glass") and Ans. 6 ("Applicant admits . . . that it is well known for PVC to have static cling property.").)

Appellants argue that Wilkins' front surface 8 is imprinted with indicia and, as a result, has no cling properties⁵. (Br. 23.) We find Appellants' argument persuasive. The Examiner has not addressed this argument, for example, by explaining why the indicia would not form a coating (e.g., of printers ink or paint (Br. 21)) over the PVC material rendering the static cling properties of the PVC incapable of securing the front surface 8 to glass (*see* FF 1).⁶ Nor has the Examiner identified another basis by which this claim limitation is met.

⁵ There is no dispute that Wilkins discloses a decorative covering E formed from a material which exhibits static cling on the rear surface 10. (*See* Br. 23, third paragraph; Ans. 8-9.)

⁶ In addition, we note that the Examiner has not explained why decorative covering E would necessarily have had static cling properties imparted to

Accordingly, we do not sustain the Examiner's rejection of claims 25-28 and 33-40 under 35 U.S.C. § 102(e) as anticipated by Wilkins.

*(2) Rejection of Claims 1, 4-8, 13, 16-19, and 41 under
35 U.S.C. § 103(a) as unpatentable over Wilkins*

As an initial matter, we note that independent claim 41 and claim 4 (dependent from claim 1), like independent claims 25, 36, and 40, require a mount having (1) a first surface carrying an adhesive coating and securable to a material such as paper and (2) a mutually opposite, second surface which is capable of securing the mount directly to glass without an adhesive. As discussed above, the Examiner has not addressed Appellants' argument that Wilkins fails to disclose a mutually opposite, second surface as claimed. Nor has the Examiner otherwise identified a disclosure or suggestion of a mount having both first and second surfaces, as claimed. Therefore, we determine that the Examiner reversibly erred in rejecting claims 4 and 41 as obvious in view of Wilkins.

The remaining claims, i.e., independent claim 1 and its dependent claims 5-8, 13, and 16-19 do not explicitly require "mutually opposite" first and second surfaces. Appellants have, however, presented additional arguments in support of patentability of these claims. Specifically, Appellants argue that Wilkins does not disclose "a mount" as claimed and does not disclose "a first surface carrying an adhesive." (Br. 21, paragraphs numbered 1. and 2.)

Based on the contentions of the Examiner and the Appellants, the issues we consider are: Have Appellants shown that the Examiner reversibly

both the front 8 and back 10 surfaces (*see* FF 5) since Wilkins only contemplates securing the back surface 10 to glass (FF 4).

erred in rejecting claims 1, 5-8, 13, and 16-19 based on unsupported findings that Wilkins discloses a mount as claimed and/or a first surface as claimed? We answer this question in the negative for the reasons discussed below.⁷

In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987).

"[T]he PTO must give claims their broadest reasonable construction consistent with the specification. . . . Therefore, we look to the specification to see if it provides a definition for claim terms but otherwise apply a broad interpretation." *In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007); *see In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (PTO should only limit a claim term based on an express disclaimer of a broader definition).

Claim 1 is directed to the combination of a mount and a single sheet of a backing material, the mount being releasably adhered to the backing material. The claimed mount has a first surface carrying an adhesive coating for securing the mount to a sheet, thereby forming a mountable arrangement. The claimed mount has a second surface for securing "such a mountable arrangement directly to glass without adhesive." (Claim 1.) The Specification states that "usually the first and second surfaces of the mount

⁷ The Examiner's reason for rejecting claims 1, 4-8, 13, 16-19, and 41 under 35 U.S.C. § 103, rather than under 35 U.S.C. § 102(e), appears to be limited to the Examiner's finding that Wilkins fails to disclose "a plurality of mounts." (*See* Ans. 4.) This limitation is recited in claim 41, but no longer appears in claim 1 in view of an amendment to claim 1 filed August 8, 2005 (*see also*, Amendment filed February 2, 2006).

will be mutually opposite. In other words, they will be diametrically opposed. Consequently, in use the mount usually will be located between the first and second material.” (Spec. 5, ll. 4-7.)

Considering the language of claim 1 in light of the Specification and claims, we determine that the scope of claim 1 is not limited to a configuration in which the first and second surfaces are on opposite sides of the mount. Rather, given its broadest reasonable interpretation, claim 1 reads on a mount in which the first and second surfaces are “mutually opposite,” as well as a mount consisting of a single layer of plastic having front and rear sides, the rear side having two surfaces, a first surface which can be adhered to glass via static cling and a second surface carrying an adhesive coating. Moreover, claim 1 as drafted does not preclude the first and second surfaces from being the same surface.

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. *Id.* at 1740. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. *Id.*

Based on our interpretation of claim 1, we are in agreement with the Examiner that claim 1 is obvious in view of Wilkins’ Figure 5 embodiment. Wilkins discloses a covering E having a rear side (surface 22) which is releasably secured to backing F by an adhesive coating, i.e., “a mount

releasably adhered to a single sheet of a backing material” and a “mountable arrangement” as claimed. (FF 4.) Wilkins discloses that the rear side (surface 22) exhibits static cling to permit covering E or a “mountable arrangement” to be secured to the glass of a picture frame. (FF 2 and 4.) In this configuration, the backing F would be positioned between covering E and the glass of the picture frame.

Appellants argue that the claimed invention is directed to “a mount,” i.e., something that “takes one material and mounts it on another,” while Wilkins is directed to “a single sheet for attaching itself - and nothing else – to a glass-covered picture.” (Br. 21.) As pointed out by the Examiner, regardless of the terminology used by Wilkins, claims are obvious where the prior art discloses or suggests the claimed structure. *See In re Danly*, 263 F.2d 844, 847 (CCPA 1959) (“[A]pparatus claims cover what a device is, not what a device does.”); *In re Rishoi*, 197 F.2d 342, 344 (CCPA 1952) (claim recitation regarding the material worked upon by a claimed apparatus does not impose any structural limitations on the claimed apparatus which serve to distinguish it from an apparatus described by the prior art which satisfies the structural limitations of the claims at issue).

Moreover, in order to establish a prima facie case of obviousness, the Examiner is not required to find an explicit teaching of using Wilkins’ decorative covering to mount a piece of paper. Nor is the Examiner required to find an explicit teaching of applying adhesive directly to Wilkins’ decorative covering E. Rather, the Examiner’s obviousness determination may be properly based, as in this case, on a finding that the ordinary artisan would have understood that Wilkins’ decorative covering E has a structure which is capable of being used as a mount and that adhesive could either be

directly or indirectly applied to decorative covering E via adhesive applied to the backing F. *See KSR*, 127 S. Ct. at 1740-41 (obviousness analysis need not seek out precise teachings directed to the specific subject matter of a challenged claim, but can take account of the inferences and creative steps that a person of ordinary skill in the art would employ); *In re Fritch*, 972 F.2d 1260, 1264-65 (Fed. Cir. 1992) (reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom).

For the foregoing reasons, we sustain the Examiner's rejection of claims 1, 5-8, 13, and 16-18 under 35 U.S.C. § 103(a) as unpatentable over Wilkins. However, we do not sustain the rejection of claims 4 and 41 under 35 U.S.C. § 103(a) as unpatentable over Wilkins.

*(3) Rejection of claims 14, 15, 31, and 32 under 35 U.S.C. § 103(a)
as unpatentable over Wilkins*

Claims 14 and 15 depend from independent claim 1. Claims 31 and 32 depend from independent claim 25.

The Examiner finds that Wilkins fails to disclose a film having Appellants' claimed thickness (claims 14 and 31) and surface area (claims 15 and 32). (Ans. 5.) The Examiner contends that one of ordinary skill in the art would have found these features a matter of routine optimization and, therefore, obvious. (Ans. 5-6.) As such, the Examiner contends that the claims 14, 15, 31, and 32 are unpatentable under 35 U.S.C. § 103(a).

Appellants have not presented arguments traversing the Examiner's findings and conclusions with respect to claims 14, 15, 31, and 32. Moreover, we find that the Examiner's position is supported by the relevant

case law. *See, e.g., In re Boesch*, 617 F.2d 272, 276 (CCPA 1980); *In re Sebek*, 465 F.2d 904, 907 (CCPA 1972).

Having sustained the Examiner's rejection of independent claim 1 as unpatentable over Wilkins, we likewise sustain the Examiner's rejection of dependent claims 14 and 15. However, because we do not sustain the Examiner's rejection of independent claim 25 as anticipated by Wilkins, and in the absence of additional findings by the Examiner establishing obviousness as to claim 25, we are constrained to reverse the Examiner's decision rejecting claims dependent claims 31 and 32.

(4) Rejection of claims 1 and 9 under 35 U.S.C. § 103(a) as unpatentable over Treglown in view of Applicant's Admission

The Examiner finds that Treglown discloses "a tab or mount having adhesive on one surface and . . . is formed of PVC or polyethylene." (Ans. 6.) The Examiner concedes that Treglown fails to teach that the mount has a static cling property. (Ans. 6.) However, the Examiner contends that it would have been obvious to one of ordinary skill in the art to have provided Treglown's mount with a static cling property since Appellants previously admitted that it was well known for PVC to have a static cling property. (Ans. 6 (citing Appellants' amendment filed August 8, 2005).)

Appellants argue that one of ordinary skill in the art at the time of the invention would have had no reason to provide Treglown's material with a static cling property. (Br. 20-21.)

The issue presented is: Has the Examiner provided a reasonable basis to conclude that one of ordinary skill in the art at the time of the invention would have been motivated to provide Treglown's mount with a static cling

property to achieve the invention as claimed in claim 1? We answer this question in the negative.

The following findings of fact are relevant:

- 6) Treglown discloses tabs 3 formed of a flexible plastic film such as PVC or polyethylene and having a thin layer of pressure-sensitive adhesive 4 applied to one surface. (Treglown 4, ll. 1-3.) The adhesive 4 temporarily attaches the tabs 3 to a backing sheet 2 prior to use. (Treglown 4, ll. 3-4.)
- 7) Treglown states that “the tabs 3 are used in mounting a poster 5 formed of paper or thin card, on a rigid substrate such as a wall 6.” (Treglown 4, ll. 7-8.)
- 8) In use, “[t]he adhesive layer is . . . used to permanently attach the tabs to the poster. . . . The poster is then mounted on the surface using lumps of proprietary adhesive putty 7 . . . applied to the exposed non-adhesive surfaces of the tabs 3.” (Treglown 4, ll. 20-24.)

A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, but may be implicit. *See In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (internal citations omitted). The analysis supporting obviousness, however, should be made explicit and should “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements” in the manner claimed. *KSR*, 127 S. Ct. at 1739.

We are in agreement with Appellants that Treglown does not contemplate attachment of the tabs 3 to a substrate by means other than adhesives. (FF 6-8.) Appellants have not admitted, and we see no

evidentiary basis which supports a finding that Treglown's PVC tabs would inherently possess cling properties. (*See* FF 5.) The Examiner's Answer is devoid of any explanation as to why the ordinary artisan would have been motivated to impart a static cling property to the tabs 3. Accordingly, we conclude that the Examiner has not met the initial burden to establish a *prima facie* case of obviousness as to appealed claims 1 and 9.

Accordingly, we do not sustain the Examiner's rejection of claims 1 and 9 under 35 U.S.C. § 103(a) as unpatentable over Treglown in view of Applicants' Admission.

NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b)

Under the provisions of 37 C.F.R. § 41.50(b), we enter the following new ground of rejection:

Claims 1, 25, and 41 are rejected under 35 U.S.C. § 102(b) as anticipated by Hendershot, U.S. 4,862,944, issued Sep. 5, 1989.

The elements of the "mount" recited in claims 1 and 25, and the "mount arrangement" recited in claim 41) "read on" the cling material mounting strips 18 with an adhesive material 20 therein as described in Hendershot.⁸

Fig. 2 of Hendershot is reproduced below:

⁸ The law of anticipation does not require that the reference teach what the subject patent or application teaches. It is only necessary that the claims, as construed, "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or fully met by it. *See Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983).

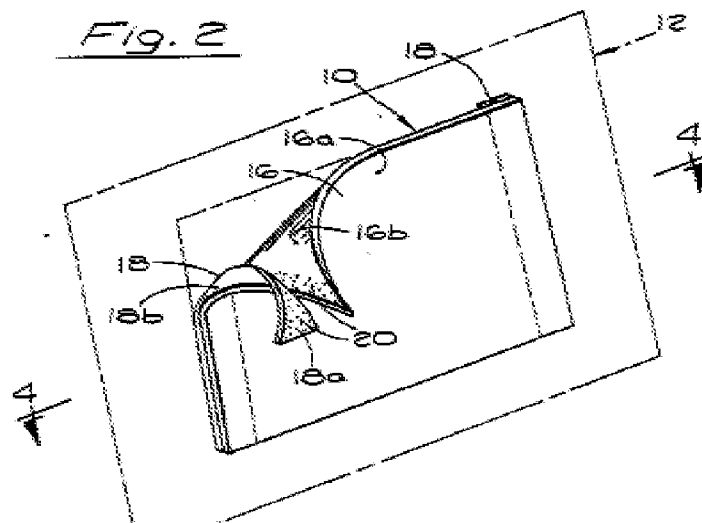


Fig. 2 of Hendershot depicts a flexible sun shield 16 (i.e., “a sheet object” as recited in each of claims 1 and 25) being mounted by a plurality of mounting strips 18 (i.e., “mount” as recited in claims 1, 25, and 41).

Each mounting strip 18 consists of a single layer of plastic “cling material” wherein a first surface has an adhesive material 20 carried thereon to secure the mounting strip to the sun shield 16 (see, col. 1, ll. 56-60; col. 2, ll. 10-11 and ll. 29-40). The opposite surface (i.e., “a second surface” as recited in each of claims 1, 25, and 41) of the cling material will repeatedly cling to a smooth glass surface without adhesive (see, e.g., col. 2, ll. 17-20; col. 3, ll. 20-24).

Thus, all the elements of independent claim 25 is described in this reference.

With respect to independent claim 41, the language “for mounting paper to glass” and “which adheres the mount to a sheet of paper” is construed as functional language that describes the respective intended use of the “plurality of mounts” and the “adhesive coating” recited therein. We

determine that the adhesive carried by the mounting strips of Hendershot, which adheres the plastic material of the sun shield to the plastic cling strips 18, would also have been capable of adhering to paper.

With respect to independent claim 1, Hendershot also describes that a protective cover (i.e., “a backing material” as recited in claim 1) may also be present when the mounting strip is obtained “on the market in a laminate form” (see, e.g., col. 2, ll. 41-55).

The claims do not define over such a laminate for at least three reasons. First, since Appellants’ claims require a sheet of plastic material “carrying an adhesive coating”; those two layers may be considered a laminate. Second, Appellants’ claims further include a backing material (for example, as required in claim 1), which is another possible layer of a “laminate”. Indeed, Appellants’ Specification describes “laminating the two materials” (namely, the plastic layer and the backing layer) to make the mount (Spec. 9:1-6). Third, each of these independent claims permit the mount to be *permanently* adhered to the sheet object (as explicitly recited in claim 25), which would be yet another possible laminate structure.

For the foregoing reasons, we reject independent claims 1, 25, and 41 under § 102(b) as anticipated by Hendershot.

We emphasize that our patentability analysis for this new ground of rejection based on Hendershot is limited to independent product claims 1, 25, and 41 only. We have not analyzed whether any of the claims which depend from these claims are unpatentable based on Hendershot alone or further in view of additional prior art. We also have not applied Hendershot to any of the method claims (i.e., claims 36-40). We leave it to the Examiner to evaluate these claims, with or without other prior art teachings

(such as, Su, US 5,462,782, previously applied and of record in this case, or Kassab, US 6,258,200, filed Mar. 31, 1999), in light of our prior art rejection of independent claims 1, 25, and 41.

CONCLUSION

The decision of the Examiner rejecting claims 25-28 and 33-40 under 35 U.S.C. § 102(e) as anticipated by Wilkins, Claims 4, 31, 32, and 41 under 35 U.S.C. § 103(a) as unpatentable over Wilkins, and claims 1 and 9 under 35 U.S.C. § 103(a) as unpatentable over Treglown in view of Applicants' Admission is reversed.

The decision of the Examiner rejecting claims 1, 5-8, and 13-18 under 35 U.S.C. § 103(a) as unpatentable over Wilkins is affirmed.

We enter a new ground of rejection of claims 1, 25, and 41 under 35 U.S.C. § 102(b) as anticipated by Hendershot, U.S. 4,862,944, issued Sep. 5, 1989.

This decision contains a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b). That section provides that, "[A] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

Regarding the new ground of rejection, Appellant must, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, exercise one of the following options with respect to the new ground of rejection, in order to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . ; or

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

In order to preserve Appellants' right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections of claims 1, 5-8, and 13-18, we defer the effective date of the affirmance until after a request for rehearing of the new ground, or, until conclusion of the prosecution for the new ground before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART; § 41.50(b)

PL Initial:
Sld

CONCURRING AND DISSENTING OPINION

KAREN M. HASTINGS, Administrative Patent Judge

I concur with the panel's decision to reverse the Examiner's rejection of claims 25-28 and 33-40 under 35 U.S.C. § 102(e) as anticipated by Wilkins. I concur with the panel's decision to reverse the Examiner's rejection of claims 4, 31, 32, and 41 under 35 U.S.C. § 103(a) as unpatentable over Wilkins. I concur with the panel's decision to reverse the Examiner's rejection of and claims 1 and 9 under 35 U.S.C. § 103(a) as unpatentable over Treglown in view of Applicants' Admission.

Finally, I concur with the panel's new ground of rejection of claims 1, 25 and 41 under 102(b) as anticipated by Hendershot.

However, I respectfully **dissent** from the majority's decision to affirm the rejection of claims 1, 5-8, and 13-18 under 35 U.S.C. § 103(a) as unpatentable over Wilkins.

It is well established that the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) *quoted with approval in KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

In my opinion, the Examiner has not met the initial burden of presenting a prima facie case of obviousness. Indeed, the Examiner does not

clearly identify why Wilkins is applied under 35 U.S.C. § 103(a) to independent claim 1; however, the Examiner does state that “[t]he release paper liner in the adhesive art is conventionally known to have silicone coating thereon for releasability.” (Ans. 4). I believe it is implicit that this statement is for establishing the obviousness of the mount being “releasably adhered to a single sheet of backing material” as set out in claim 1.

However, I believe the Examiner has fundamentally misinterpreted the disclosure of Wilkins. The Examiner’s obviousness conclusion relies on the mistaken assumption that the optional “tacky adhesive” is in addition to the “material exhibiting static cling”⁹. It is my belief that a careful reading of the reference does not support this assumption.

According to Wilkins:

[T]he decorative covering D is *preferably* formed from a material exhibiting static cling so that the covering can be readily mounted on numerous surfaces including glass overlying an original picture. The material *may* be a vinyl formed from a polyvinyl chloride material through a well known manufacturing process. Once again the particular material used can be varied provided that the chosen material exhibits static cling to permit the decorative covering D to be electrostatically adhered over the original picture B. *Optionally, a tacky adhesive may be used to secure the decorative covering D to the original picture B.*

(Col. 3, ll. 50-60; emphasis provided)

⁹ The Examiner’s finding of anticipation for claims 25-28 and 33-40 also relies upon this mistaken assumption. However, the panel agrees that finding fails for other reasons, as set out in the majority opinion.

It is clear that, in context, “*Optionally, a tacky adhesive may be used to secure the decorative covering D to the original picture B.*” means that the decorative covering D may alternatively be applied via an adhesive **instead of** via the “preferred” material exhibiting static cling.

The first option described in the reference is the use of a material exhibiting static cling (i.e., “*preferably* formed from a material exhibiting static cling”; emphasis provided); the second option described is the use of a tacky adhesive to secure the decorative covering to the original picture. I find nothing in Wilkins that describes or suggests using these two options together; nor does the Examiner provide a reason for doing so. The Examiner has not cited to any disclosure in Wilkins which teaches or would have suggested adding an adhesive to a static cling material. To the contrary, it appears there would have been no need for a tacky adhesive if the decorative covering was adhered by forming it of a cling material. Further, the use of a tacky adhesive on the cling material would have de facto destroyed any “cling” property of the material.

Wilkins discloses a second embodiment (shown in FIG. 5) which differs from the first embodiment in that the rear surface does not have a template or an instruction area. (Col. 4, ll. 24-29.)

Rather, a protective backing F is provided which has a front surface 20 directly adjacent the rear surface of the decorative covering E. The protective backing further has a rear surface 22 with a template 24 and an instruction area 26. The protective backing F *may* be formed from any material which can be electrostatically adhered to the decorative covering E. *Optionally, a tacky adhesive may be used to secure the decorative covering E to the original picture.*

(Col. 4, ll. 29-36; emphasis provided.)

Again, the rejection merely states “[t]he release paper liner in the adhesive art is conventionally known to have silicone coating thereon for releasability.” (Ans. 4), for (implicitly) establishing the obviousness of the protective backing F being of a material such that the mount is “releasably adhered to a single sheet of backing material” as set out in claim 1.

However, this second embodiment, like the first embodiment, may only be reasonably read to state that the tacky adhesive is an alternative option to one wherein the decorative covering E is made of a material exhibiting static cling. When the decorative covering E is made of a material exhibiting static cling, this would have necessitated the use of a backing F made from a material to “electrostatically adhere” to the decorative covering E (note, backing F “*may*” be such a material). Alternatively, if a tacky adhesive is used to secure the decorative covering E to the original picture, the protective backing F would not need to be of such a material, namely one that would electrostatically adhere to the decorative covering, since the decorative covering would not have been of a material exhibiting static cling.

It is my belief that the Examiner has not provided any reasoning or rationale to support the legal conclusion of obviousness over the teachings of Wilkins alone. The Examiner has not cited to any disclosure in Wilkins which teaches or would have suggested adding an adhesive to a static cling material. Again, I find no evidentiary support on this record for the proposition that Wilkins describes or suggests using the two options together. Further, the use of a tacky adhesive on the cling material would have de facto destroyed the “cling” property of the material where the adhesive was located. Moreover, the Examiner has not provided this record with any rationale explaining why an artisan would have added an adhesive to cling material. On its face, it appears an artisan would not have done so since there would have been no need for a tacky adhesive if the decorative covering sheet was formed of a cling material.

Consequently, I would have found that the Examiner failed to establish a prima facie case of obviousness with respect to claims 1, 5-8, and 13-18, and I would reverse the Examiner’s rejection of claims 1, 5-8, and 13-18 under 35 U.S.C. § 103(a) as unpatentable over Wilkins.

Appeal 2008-1520
Application 09/905,261

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